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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/753,062

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EXAMINER

WEST, THOMAS C

ART UNIT

PAPER NUMBER

3621

MAIL DATE

DELIVERY MODE

05/29/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/753,062	Applicant(s) OSADA, MAMORU	
	Examiner THOMAS WEST	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3-17-09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is in reply to the Request for Continued Examination filed March 2, 2009.
2. Claims 1-10 are currently pending and have been examined.

Information Disclosure Statement

3. The Information Disclosure Statement filed on March 17, 2009 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

Specification

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: claim 1 recites a "comparison unit", claims 1, 8, 9, 10 recite a "start program management unit", claims 1, 2, 8, 9, 10 recite "storage unit", claim 9 recites a "setting instruction", claims 1, 5, 6, 7 recite a "license management unit", claim 1 recites a "license information acquisition unit", all of which have no support in the specification.

Claim Rejections - 35 USC §101

5. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 8 is rejected under 35 U.S.C. §101 because the claimed invention is the claimed invention is directed to non-statutory subject matter.

Based on Supreme Court precedent¹ and recent Federal Circuit decisions, § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing.² If neither of these requirements is met by the claim(s), the method is not a patent eligible process under 35 U.S.C. § 101. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

² The Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advances. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972).

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being changed to a different state or positively recite the subject matter that is being transformed.

In this particular case, the claim(s) fail prong (1) because the method steps are not tied to a machine. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 8, 9, 10 are rejected under U.S.C. 102(b) as being unpatentable over Nakamura (Nakamura), U.S. Patent Application No. 20020143568.

Claims 1, 8, 9, 10:

Nakamura, as shown, discloses the following limitations:

- a storage unit that stores apparatus identification information for identifying the image forming apparatus, and a plurality of programs for realizing optional functions (see at least paragraphs 8, 11, 34, 95)
- a start program management unit that holds start program identification information indicative of whether each of the plurality

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of programs has been set to a program to be executed at a start of the image forming apparatus, in association with each of the plurality of programs (see at least paragraphs 11, 95)

- a license management unit that permits use of the plurality of programs on a program-by-program basis (see at least paragraphs 41-43, 88-91, 95)
- a license information acquisition unit that acquires license information including apparatus specifying information and program specifying information for specifying a program from an external unit (see at least paragraphs 41, 48, 50-54, 91)
- a comparison unit that compares the program specifying information with the start program identification information, when the apparatus specifying information included in the license information acquired by said license information acquisition unit and the apparatus identification information stored in said storage unit match, and the program specified by the program specifying information included in the license information is identical to any of the plurality of programs (see at least paragraphs 9, 11, 41, 87, 91, 98, fig. 9)

Regarding claims 1, 8, 9, 10, the MPEP states “Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure, does

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not limit the scope of a claim or claim limitation”, hence limitations directed to how Applicant’s method performs “when” something occurs (MPEP 2106 II C).

- said start program management unit changes the start program identification information corresponding to the program specified by the program specifying information to be executed at the start of the image forming apparatus, when the program specified by the program specifying information has not been set to a program to be executed at the start of the image forming apparatus in said start program management unit as the result of comparison by said comparison unit. (see at least paragraphs 11, 87, 98)

Claims 2:

Nakamura, as shown, discloses the following limitations:

- an input unit via which information is inputtable by operation of an operator, and an external storage unit that holds the license information (see at least paragraph 54)
- license information acquisition unit is responsive to input of predetermined instruction information via said input unit by the operation of the operator, for reading and acquiring the license information from said external storage unit (see at least paragraph 41)

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Claims 3:

Nakamura, as shown, discloses the following limitations:

- a communication unit that communicates with the external unit which has a function of inputting the license information by operation of an operator, and a function of transmitting the license information inputted by the operation of the operator (see at least paragraphs 41, 91)
- wherein said license information acquisition unit receives and acquires the license information transmitted from the external unit, via said communication unit (see at least paragraphs 41, 91)

Claims 4:

Nakamura, as shown, discloses the following limitations:

- a communication unit that communicates with the external unit which is capable of holding the license information, and an inquiry unit that periodically inquires of the external unit via said communication unit whether the license information is held in the external unit (see at least paragraphs 41, 91)
- license information acquisition unit is responsive to a notification that the license information is held in the external unit, given by the external unit in response to the inquiry, for acquiring the license

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information from the external unit via said communication unit (see at least paragraphs 41, 91)

Claims 5:

Nakamura, as shown, discloses the following limitations:

- a clock unit that outputs time information (see at least paragraph 57)
- the license information includes an expiration date of the program specified thereby (see at least paragraph 57)
- a license information holding unit that holds the license information associated with each of programs set to a program to be executed at the start of the image forming apparatus (see at least paragraphs 41, 91)
- an expiration date determining unit that compares the expiration date included in the license information associated with each of the programs set to a program to be executed at the start of the image forming apparatus with the time information outputted from said clock unit, to thereby determine whether the expiration date has passed (see at least paragraph 57)
- a limiting unit that limits execution of each of the programs set to a program to be executed at the start of the image forming apparatus,

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based on a result of the determination by said expiration date
determining unit (see at least paragraph 57)

Claims 6:

Nakamura, as shown, discloses the following limitations:

- a totalizing unit that totalizes amounts of usage of apparatus resources used by operation of the programs on a program-by-program basis (see at least paragraphs 102, 104)
- license information includes an upper limit of an amount of usage of resources usable by each program specified by the license information (see at least paragraphs 102, 104)
- a license information holding unit that holds the license information associated with each of programs set to be executed at the start of the image forming apparatus (see at least paragraphs 41, 91)
- a usage determining unit that determines whether the amount of usage of the apparatus resources used by each of the programs set to be executed at the start of the image forming apparatus has reached the upper limit thereof (see at least paragraphs 102, 104)
- a limiting unit that limits execution of each of the programs set to a program to be executed at the start of the image forming apparatus, based on a result of the determination by said usage determining unit (see at least paragraphs 102, 104)

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 7 is rejected under U.S.C. 103(a) as being unpatentable over Nakamura, U.S. Patent Application No. 20020143568 (Nakamura), in view of Quistgaard, U.S. Patent Application No. 20030009102 (Quistgaard).

Claims 7:

Nakamura discloses the limitations as shown above. Nakamura does not disclose encrypted information, but Quistgaard does:

- encrypted information, and said license management unit further comprises a decrypting unit that decrypts the license information (see at least paragraph 27).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Nakamura to include the encrypted information of Quistgaard since this protects the secrecy and distribution of license keys.

Response to Arguments

10. Applicant's arguments filed March 2, 200 have been fully considered but they are not persuasive. Applicant's arguments will be addressed in sequential order as they were set forth in the "Remarks" section on the above date. Applicant argues that Nakamura fails to teach acquiring license information from an external device. This is disclosed in at least paragraphs 41-43 and 91, describing a user requesting a purchase of a license, subprogram (subprogram license) or purchase of a start of trial (trial license), in which the user receives an electronic key which includes an authorized key. License here meaning a license (authorization) to use certain trial or subprogram features. The user may also start a trial of all available subprograms in the device configuration after obtaining an authorization key, paragraph 41. Nakamura further discloses, "The electronic key thus issued allows the user to release a given program (setting a start program) from access-protect (program specifying information) (i.e., start the authorized use of the program) or start a trial use of the program", paragraph 41. Here, releasing a program under access-protect inherently requires accessing license information (program specifying information) regarding said program such as "device configuration (apparatus specifying information) of the image processing device 11 used by the user who made the request, or the user's device use patterns", paragraph 41. Nakamura also shows from the above discussion, setting a start program based on the specifying information. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "managing a trial program") are not recited in the rejected claim(s).

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Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant argues that Nakamura does not disclose upgrades. Nakamura discloses, “When the user, who learned about the foregoing guidance information, desires any of the functions, he/she can request purchase or start of a trial of, the subprogram P20 corresponding to the desired function by simply advising a service center, etc., of the request for upgrading”, paragraph 41. The applicant argues that Nakamura fails to disclose setting a start program based on the specifying information included in the license information and apparatus identification in the storage unit matching the program specified. Nakamura discloses in figure 9 and paragraph 52, “the electronic key is discriminated by checking it against different keys one after another (matching), that is, if it is an ‘authorized key’ issued upon purchase of the subprogram P20 as being a commercial product or a ‘trial key’ or a ‘specified key’ which should be inputted during a trial period (steps S2 to S4). Here, when the electronic key is the authorized key, the subprogram corresponding to the authorized key is released from access-protect (step S5)”.

Regarding how Applicant’s claimed apparatus is intended to perform (e.g. “that stores”, “that permits”, “that acquires”). It has been held that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2114; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44

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USPQ2d 1429 (Fed. Cir. 1997)).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas West whose telephone number is 571-270-1236. The examiner can normally be reached on Tuesday and Wednesday 7:30am - 5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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